

REMARKS

A Petition for Extension of Time is being concurrently filed with this Amendment. Thus, this Amendment is being timely filed.

Applicants submit that the present amendments are fully supported in the present specification as filed and add no new matter. Further, the amendments herein address issues that are first raised in the outstanding Office Action, and were not made earlier, because the first indication to Applicants that the present amendments would be needed was in that Office Action (e.g., to address the new matter objection and new matter rejection). Therefore, entry of the present amendment is proper, and is respectfully requested.

In the alternative, if the Examiner continues with the rejections of the present application, it is respectfully requested that the present Reply be entered for purposes of an Appeal. The Reply reduces the issues on appeal by overcoming the objection and/or rejection under 35 U.S.C. § 112, first paragraph. Thus, the issues on appeal would be reduced.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

Status of the Claims

In the present Reply, claims 1 and 16 have been amended. Further, claims 19-27 have been added. Also, claims 12 and 14-18 stand withdrawn from consideration.¹ Thus, claims 1-27 are pending in the present application.

¹ Clarification of the status of claim 15 is respectfully requested.

No new matter has been added by way of these amendments because each amendment is supported by the present specification. For example, the amendment to claim 1 is for clarification purposes, wherein support can be found at page 128, lines 19+ and page 130, lines 16+. Support for the amendment to claim 16 is found in claim 1.

New claims 19-27 are drawn to other embodiments of the present invention and have been added for the Examiner's consideration. Support for these claims is found in claims 2-6 and 8-11 (except the new claims depend on claim 16). No new matter has been added with these new claims.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Claims 16-18

As stated in paragraphs **I.** and **III.** of the Office Action, the Examiner has withdrawn claims 16-18. However, Applicants note that claims 16-18 are essentially directed to a method of producing the silver halide photographic light-sensitive material of claim 1. Applicants note how claim 16 has been amended herein. Further, it is clear that the method step(s) have been considered in view of the comments in the Office Action at, e.g., the bottom of page (discussing how a cited reference discloses a composite latex formed from hydrophobic monomers and inorganic microparticles to match what is claimed).

Thus, Applicants respectfully request reconsideration and rejoinder of claims 16-18. Further, favorable action is requested of new claims 19-27.

In the event that the Examiner does not rejoin the method claims with the product claims at this stage, the Examiner is reminded that should the product claims be found allowable, the process claims which depend from or otherwise include all the limitations of the allowable product claims are to be rejoined, see MPEP § 821.04. It is noted that the method claim 16 includes all of the limitations of product claim 1.

Objection under 35 U.S.C. § 132(a)

The amendment filed May 22, 2006, has been objected to as stated in paragraph IV. of the Office Action (at pages 3-4). Specifically, the Examiner states that the recitation of "one" in the phrase "the silver halide emulsion layer contains a composite latex formed by polymerizing one or more hydrophobic organic monomers in the presence of inorganic microparticles" of claim 1 constitutes new matter. In this regard, claim 1 has been appropriately amended. Claim 1 now has clear claim language, and withdrawal of this objection is respectfully requested.

Paragraph V. of the Office Action

The Examiner appears to have temporarily withdrawn claims 12 and 14 until an allowable species is determined (e.g., claim 1 is allowed). Thus, when allowable subject matter is found, Applicants respectfully request expansion of the search of all applicable species and the rejoinder of these claims.

Issues under 35 U.S.C. § 112, First Paragraph

Claims 1-11 and 13 stand rejected under 35 U.S.C. § 112, first paragraph, for asserted lack of written description (see paragraph VI. of the Office Action). Applicants respectfully traverse.

Claim 1 has been appropriately amended and this rejection is rendered moot. Accordingly, withdrawal of this rejection is respectfully requested.

Issues under 35 U.S.C. § 102(b)

Claims 1-6, 8, 9 and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Arai '170 (U.S. Patent No. 6,013,410) (newly cited; see paragraph VIII. of the outstanding Office Action). Applicants respectfully traverse this rejection.

In the previous Amendment dated May 22, 2006, Applicants added the claim language of “the silver halide emulsion layer contains a composite latex formed by polymerizing one or more hydrophobic organic monomers in the presence of inorganic microparticles” into claim 1. This new rejection appears to be directed to how Arai '410 could account for the recently added claim language in pending claim 1. Specifically, the Examiner refers Applicants to the composite latex made by inorganic hydrophobic monomers and inorganic microparticles with reference to column 3, lines 38+ and other parts of Arai '410.

First, Applicants traverse the finding of inherency, as there is a presumption that the claimed invention is patentable and the Examiner has not shifted the burden to Applicants to prove patentability. Applicants note the following case law which states: “The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention on any ground is

always upon the examiner.” *Ex parte Parks*, 30 USPQ2d 1234, 1236 (citing *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992)); *see also In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

Second, the Examiner has not established that the instantly claimed composite latex is the same as the Arai ‘410 latex. Applicants note the problem associated with the previously cited Sudo *et al.* ‘170 reference. (U.S. Patent No. 5,424,170). For instance, in Example 5, Sudo ‘170 discloses that its “polymer latex 1” is mixed with a colloidal silica to form the coating composition for a silver halide emulsion layer (see column 74, lines 3 and 5). But in the claimed invention, the inorganic particles are homogenously and completely covered with the polymer latex. This particular structure cannot be produced by merely mixing the polymer latex with the inorganic particles (as in the case of Sudo ‘170). This is because the mixing of these materials would cause partial coagulation due to an interaction between the polymer latex and the inorganic particles. Applicants note that the composite latex of the presently claimed invention is free from such coagulation.

Third, Applicants note that the Arai ‘410 reference discloses that its latex can be made using the method described in EP-A-772083. However, it appears that EP-A-772083 is no longer available to the public. Thus, it appears that Arai ‘410 is not even enabled such that one of skill in the art could reproduce the Arai ‘410 latex since the EP method is not even publicly available. In this regard, a patent claim “cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.” *Elan Pharm., Inc. v. Mayo Found. for Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373 (Fed. Cir. 2003).

Accordingly, because “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,” the cited Arai ‘410 reference cannot be a basis for a rejection under § 102(b). *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants also note application of *Elan Pharm.* above as well. Thus, because of the lack of disclosure of all features as instantly claimed, the rejection in view of Arai ‘410 is overcome. Reconsideration and withdrawal are respectfully requested.

Applicants also note that the pending method claims are patentably distinct from the Arai ‘410 embodiment. Claim 16 in part recites: “heating the layers-formed support at a temperature of 30 to 60°C”. In this regard, Arai ‘410 fails to disclose the claimed heating step within the specified temperature range (see, e.g., column 41, lines 16-22 of Arai ‘410). The advantageous effects of the claimed heating step are even described by Applicants at page 83, line 8 to 22 of the specification as follows:

... The light-sensitive material of the present invention is preferably subjected to a heat treatment at any time after coating and before development. Although the heat treatment can be successively carried out immediately after coating or carried out after a certain period of time has passed, it is preferably carried out after a short period of time, for example, within 1 day. The heat treatment is carried out mainly in order to promote film hardening reaction so as to obtain film strength sufficient to withstand development. The heat treatment conditions should be appropriately determined depending on the type of hardening agent, amount thereof, pH of the film, required film strength etc. The heat treatment is preferably carried out at 30 to 60°C, more preferably 35 to 50°C. The term for the heat treatment is preferably for 30 minutes to 10 days.

(Applicants' emphasis added). Arai '410 also fails to recognize such an advantage of the claimed heating step. Thus, Arai '410 fails to also disclose all claimed features of the pending method claims.

Reconsideration and withdrawal of this rejection are respectfully requested.

Issues under 35 U.S.C. § 103(a)

Claims 1-6, 8, 9 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Arai '170 (see paragraph **VIII.** of the outstanding Office Action).

Also, claims 7 and 10-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Arai '410 considered in view of Morishima *et al.* '040 (U.S. Patent No. 5,994,040) and Sudo *et al.* '170 (U.S. Patent No. 5,424,170) (see paragraph **IX.** of the Office Action).

Applicants respectfully traverse, and reconsideration and withdrawal of these rejections are respectfully requested.

(i) First rejection

The deficiencies of Arai '410 are discussed above. In this regard, a *prima facie* case of obviousness requires three things, which includes that the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). Thus, the rejection stated in paragraph **VIII.** of the Office Action has been overcome.

(ii) Second rejection

Regarding the rejection stated in paragraph **IX.** of the Office Action, the cited Sudo '170 and Morishima '040 do not account for the deficiencies of the primary reference of Arai '410. Specifically, the secondary references also fail to disclose the claimed heating step.

For example, as stated in Applicants' previous reply dated May 22, 2006, Sudo '170 fails to disclose all claimed features, including "the silver halide emulsion layer contains a composite latex formed by polymerizing one or more hydrophobic organic monomers in the presence of inorganic microparticles." This deficiency in Sudo '170 is also apparent in reviewing its own Examples.

As another example, Morishima '040 does not disclose a latex formed by polymerizing one or more hydrophobic organic monomers in the presence of inorganic microparticles. In its working examples, Morishima '040 uses a coating composition for an emulsion layer comprising polyethyl acrylate latex or a mixture of polyethyl acrylate latex and latex copolymer in which the ratio of butyl acrylate/acrylic acid/2-acetoxyethyl methacrylate is 80/4/16 (see column 186, lines 30-32; column 190, lines 34-36; column 220, line 39; and column 228, lines 65-66) (see pages 17-19 of the May 22 response by Applicants).

Accordingly, both of Sudo '170 and Morishima '040 also fail to disclose all claimed features. Thus, a *prima facie* case of obviousness has not been established. *In re Vaeck; supra.*

Moreover, the cited references must suggest the desirability of the modification. *In re Brouwer*, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995). The cited references do not suggest any advantage to be gained by making the Examiner's proposed combination. Thus, one of ordinary skill in the art would also lack the requisite motivation to combine the three disclosures in an

effort of applying the heating step to produce the silver halide photographic light-sensitive material before the claimed invention was made.

Accordingly, both rejections have been overcome. Reconsideration and withdrawal of these rejections are respectfully requested.

Conclusion

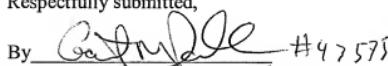
In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez, Reg. No. 48,501, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: December 4, 2006

Respectfully submitted,

By  #47575
Marc S. Weiner
Registration No.: 32,181
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road, Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant